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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,782	03/26/2004	Elia Rocco Tarantino	PATINV.0005P	9658
32856 7590 05/08/2009 WEIDE & MILLER, LTD. 7251 W. LAKE MEAD BLVD. SUITE 530 LAS VEGAS, NV 89128				
EXAMINER DHILLON, MANJOT K				
ART UNIT		PAPER NUMBER		
3714				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/810,782

**Applicant(s)**

TARANTINO, ELIA ROCCO

**Examiner**

MANJOT K. DHILLON

**Art Unit**

3714

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This office action is in response to applicant's response filed on 1/15/09.

Applicant amends claims 1, 2, 5, and 6, and responds to rejections. Claims 1-9, and 16-17 are pending.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 6, 8, 9, 16, and 17 are rejected under 35 U.S.C. 103(a) as obvious over Luciano, Jr. (US 2003/0232638 A1) in view of Beaulieu et al. (US 2003/0017865 A1).

Concerning claims 1, and 8, Luciano, Jr. teaches a method of playing a game of keno at a gaming device comprising the steps of: displaying a set of keno numbers [Fig.

**3, item 102**]; accepting input from a player regarding one or more player selected numbers from said keno numbers **[Fig. 4, checkmarks]**; selecting a set of game numbers **[0010/0052]**; designating said player selected numbers with a first indicator **[Fig. 4, checkmarks]**; determining if one or more of said game numbers match one or more of said player selected numbers **[0011/0052]**; as to each player number which is matched by a game number, displaying a match indicating secondary indicia in association with said matched player number, said match indicating secondary indicia having an attribute indicating to said player that said player number was matched **[0052/0055, Fig. 5, item 154]**. Indicia can be defined as "mark, or sign". Luciano, Jr. teaches as to each player number which is not matched by a game number, displaying a non-match indicating secondary indicia in association with said unmatched player number, said non-match indicating indicia differing from said match indicating secondary indicia, and said non-match indicating secondary indicia having an attribute indicating to player that said player was not matched **[0052/0055, Fig. 5, item 152]**. The box that is unchecked and shaded (i.e. 152) shows non-matching indicia. Luciano, Jr. teaches determining the outcome of said game **[0056]**. Luciano, Jr. fails to teach removing said first indicator and displaying a match indicating secondary indicia in association with said matched player number, and said match indicating secondary indicia not including said first indicator and as to each player which is not matched by a game number, removing said first indicator and displaying a non-match indicating secondary indicia in association with said unmatched player number, said non-match indicating secondary indicia not including said first indicator. Beaulieu discloses a

gaming system with in-game player stimulations. Beaulieu teaches removing said first indicator and displaying a match indicating secondary indicia in association with said matched player number **[Fig. 15 and Fig. 16, 0088]** said match indicating secondary indicia not including said first indicator and said match indicating secondary indicia having an attribute indicating to said player that said player number was matched **[Fig. 15 and Fig. 16, 0088]**. The more numbers the player wins, the animations are replaced with further excited animations. As seen in the figures, a smiling happy face is replaced with a grinning happy face. Beaulieu teaches that each player which is not matched by a game number, removing said first indicator and displaying a non-match indicating secondary indicia in association with said unmatched player number, said non-match indicating secondary indicia not including said first indicator, said non-match indicating indicia differing from said match indicating secondary indicia, and said non-match indicating secondary indicia having an attribute indicating to player that said player was not matched **[Fig. 17 and Fig. 19, 0091]**. While the examples given by Beaulieu relate to a video slot machine, Beaulieu teaches similar modifications can be made for other games including Keno **[0111]**. It would be obvious to substitute the shaded check mark as disclosed by Luciano, Jr. with various symbols as disclosed by Beaulieu et al. because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Concerning claim 6, Luciano, JR. teaches wherein a matching indicating or non-match indicating secondary indicia displayed in physical proximity to each player selected number **[0055, Fig. 5, item 152 and 154]**. The box that is unchecked and

shaded (i.e. 152) shows non-matching indicia, while the box that is checked and shaded shows matching indicia.

Concerning claim 9, Luciano, JR. teaches said steps of displaying are performed on a video display of said gaming device **[0027]**.

Concerning claim 16, Luciano, JR. teaches wherein the first indicator comprises highlighting of said keno numbers which comprise player selected numbers **[Fig. 4]**. Luciano, JR. teaches placing a check mark on the player selected numbers, to replace the check mark with any symbol or color is well known to one of ordinary skill in the art and considered design choice.

Concerning claim 17, Luciano, JR. teaches including the step of indicating said selected game numbers by a second indicator **[0052/0055, Fig. 5, item 154]**.

5. Claims 2-5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano, JR. (US 2003/0232638 A1) or Luciano, JR. and Beaulieu et al. (US 2003/0017865 A1) in view of Bennett et al. (WO 2000/32286 A1).

Luciano, JR. discloses the game selected symbol can be animated figures **[0032]**, however, lacks disclosing the specific actions of the animated figures. The international application to Bennett et al. teaches various methods of player information delivery in a game. Concerning claims 2-5, and 7, Bennett et al. teaches various animated smiley characters, other than numbers, that differ from one another in appearance to indicate happiness or celebration in a game appear when player has won or a match in indicated. These characters have mannerisms that provide

information to the player [pg. 25, figures 14 –17]. The character may also indicate unhappiness or loss by exhibiting a sour expression [pg. 21, lines 3-4].

It would have been obvious to combine the keno game in the Luciano, JR. publication with the animated figures in the international application to Bennett et al, because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

#### ***Examiner's Note***

The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

#### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-9, 16 and 17 are based on the amendments & are answered in the rejection above. Please see newly cited sections and explanations relating to the amended subject matter above.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MANJOT K. DHILLON whose telephone number is (571)270-1297. The examiner can normally be reached on Mon. - Thurs., 7 AM - 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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